

REMARKS

The Examiner is thanked for the Official Action of October 17th, 2008 and for the opportunity to conduct a telephone interview on December 17th, 2008. This request for reconsideration and request for continued examination is submitted along with the attached amendment and is intended to be fully responsive thereto.

Advisory Action Remarks

The Examiner is thanked for recognizing Applicant's arguments and for the removal of the § 112 rejection.

Rejections under 35 U.S.C. § 103(a)

In the Final Office Action of October 17th, 2008, The Examiner relied substantially on the incorporation of new matter for the basis of his § 103 rejection. As previously argued, Applicant believes that the Examiner was mistaken in his "new matter" assessment. The Examiner has recognized that this is not new matter and therefore Claim 1 should now be allowable.

In the Advisory action of March 4th, 2009 the Examiner reasserts the rejection of Claim 1 over Japan ('121) in view of Ballew and Aksamit. Applicant disagrees for at least the following reasons.

Claim 1 with this submission is amended as:

Claim 1 (currently amended): A chainsaw sharpener for a saw chain with a round shaft-shaped grinding tool which is attached to an end of a drive shaft of an electric motor, and which receives rotation force of the electric motor so as to rotate,

wherein mounted on and forward of the electric motor of a sharpener body via a mounting portion is a guide body having,

formed therein, an upper plate face and wall faces being pressed against a guide bar of the chainsaw, which have a substantial X-shape as seen in plain view, extending in two directions, and which are fit into and along an upper part of the saw chain in alignment with a sharpening angle of either a left or right cutter blade of the saw chain, in which the wall faces can push forward the guide bar of the chainsaw by pushing forward the electric motor held by a sharpening worker;

~~wherein the upper plate face is placed on cutter blades,~~

wherein formed at a substantially central surface of the guide body is an exposure portion made of an opening or a curved portion or both of these which make it possible to watch, from above, the grinding tool and at least a cutting edge of a cutter blade to be sharpened, and

wherein provided on inside or side of the exposure portion is a guide portion for pressing, from above, the cutter blade to be sharpened so as to prevent the cutter blade from wobbling or tilting, and further to define an accurate cutting edge angle.

The specification provides sufficient support to allow the amendment and to thus make the claim allowable as described hereinbelow.

(1) The specification of the present application in several passages describes the operational relationship between the wall faces (81a, 81b, 81c, 81d), the guide bar (40) and the electric motor (3) held by a sharpening worker. For example:

(a) paragraph [0049] states:

“It (chainsaw sharpener) enables sharpening of a cutter blade (31, 32), aligned with an accurate sharpening angle and cutting edge angle, by just aligning the

orientation of an electric motor (3), held by a single hand (of a sharpening worker), with a horizontal direction on either left or right, and pushing it forward” (parenthesized expressions and numbers added for clarification). The term “sharpening worker” appears four times in the present specification, specifically in paragraphs [0025], [0040], [0042], and [0045].

(b) Paragraph [0012], describes:

“an accurate sharpening angle and cutting angle can be obtained by fitting the guide body (8) into the saw chain (30) from above...and pushing it forward” (parenthesized numbers added).

(c) Paragraph [0039], describes:

“pressure plate faces 81a, 81b, 81d, 81c which serve as wall faces for pressing against a guide bar (saw plate) (40) of the chainsaw, and which are directed downward, are formed” (parenthesized number added). (Note here that the guide bar is a saw plate (metal plate) shown in FIGS. 8 and 11 with reference numeral 40 which supports the saw chain 30 in the circumferential direction.)

It is apparent from these examples that the “wall faces” are allowed to push the guide body (8), more specifically guide bar (40) of the chainsaw, by pushing forward the electric motor (3) held by a sharpening worker, or conveniently by a single hand of the sharpening worker.

(2) Applicant assumes that the Examiner is referring to Ballew, patent number 3,905,118, and not patent number 3,905,115 as is cited by the Examiner throughout prosecution. All arguments are made in reference to 3,905,118.

It is true that the file guide of Ballew has members which can be referred to as wall faces. However, the file guide is supported to be movable back and forth relative to the file so that the file guide cannot be mounted and fixed on the chain unless the file guide is held by hand. The structure of Ballew is entirely different from that of the present invention. Ballew is not mounted to an electric motor or anything else for that matter. It is simply a hand held alignment tool. Ballew does not have wall faces that

retain and hold the chain in place nor does Ballew have a chain guide body. In Ballew it is entirely up to the user to maintain the grinding angle and chain position. Nor does Ballew disclose the opposing walls forming an X-shape. The X marks that the Examiner may be referring to in Ballew are actually just “reference marks” cut into the reference plate to aid the user in lining up the file. The Examiner is directed to Column 1, lines 61-68 of Ballew. Again, this is entirely different from the X structure of the present invention that actually aligns the chain using the X shaped guide body.

The present invention has “a guide body having, formed therein, an upper plate face and wall faces being pressed against a guide bar of the chainsaw, which have a substantial X-shape as seen in plain view, extending in two directions, and which are fit into and along an upper part of the saw chain in alignment with a sharpening angle of either a left or right cutter blade of the saw chain. Obviously this structure is different from that of Ballew in that the chain is fitted into the X pattern, thus providing support for the chain (not disclosed in Ballew), providing proper sharpening angle (not disclosed in Ballew) and thus preventing the chain from wobbling while sharpening (not disclosed in Ballew). Ballew does not disclose the same type of faces as those taught in the present invention, therefore, it would not have been obvious to modify Ballew to arrive at the present invention.

The wall faces (members which can be referred to as wall faces) are those to be pressed against the side walls of the chain, and not those to be pushed forward to be pressed against the guide bar of the chainsaw. In Ballew, the saw chain supported by the guide bar is supported to be likely to wobble, so that even if the file guide is held by hand to press it against the chain, the file guide is likely to wobble along with the chain.

(3) It is true that the frame (10) of Aksamit also has members (inner surfaces 22) which can be referred to as wall faces. However, similarly as in the file guide of Ballew, the frame (10) of Aksamit is supported to be movable back and forth relative to the file. Thus, the chain cannot be fixed by the frame (10) unless the frame (10) is held by hand to press it against the chain and the guide bar, or unless the frame (10) is mounted on the chain to press the guide bar from the front and back of the guide bar. The Examiner

states that Aksamit discloses a chainsaw sharpener having guide wall faces which are pressed against a guide bar of the chainsaw to stabilize the sharpening tool during use. However, the structure of the walls in Aksamit are again entirely different from that of the present invention. The guide walls that the Examiner references in Aksamit actually form a U shape, extended guide that sits over the guide bar whereas the wall faces of the present invention are shorter and are more easily moved than those of Aksamit.

(5) Japanese Laid-open Utility Model Publication Sho 61-24121 is irrelevant to the present invention because it has no member to be pressed against a guide bar.

(6) Applicant respectfully submits that the Examiner has not met his burden of proof to establish *prima facie* obviousness. First, the prior art references must teach or suggest all the claim limitations. In the case of the present invention, Japanese Laid-open Utility 61-24121 does not include any members pressing against a guide bar. Next, the X-shape is not present in Ballew. As argued above, the X marks that the Examiner may be referring to in Ballew are actually just “reference marks” cut into the reference plate to aid the user in lining up the file, it is not actually an X-shape, as taught in the present application. Finally, it would not have been obvious to combine Aksamit with the other two references.

Next, to establish *prima facie* obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. MPEP 2143.03. Here, Applicant believes that the Examiner presents motivation to combine the references based on a misreading of the references, particularly Ballew. Because all of the elements are not disclosed in the references it would not have been obvious to combine them to arrive at the present invention.

Conclusion

Neither the file guide of Ballew nor the frame (10) of Aksamit is designed or conceived to be pushed forward by a hand (of a sharpening worker) which holds a file

(i.e. which holds an electric motor). It is believed clear that the guide body and the wall faces of the present invention are completely different from the file guide and the wall faces (members which can be referred to as wall faces) of Ballew, and also from the frame (10) and the wall faces (members like the inner surfaces 22 which can be referred to as wall faces) of Aksamit.

In view of the above, Applicant respectfully submits that Claim 1 recites statutory subject matter that is novel and new, is subject matter of the present invention and is fully supported in the disclosure of the present invention, and therefore respectfully requests that Claim 1 be found allowable and that this application be passed to issue. No new matter has been included.

If for any reason, the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact the Applicant's undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper has not been timely filed, the Applicant respectfully petitions for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 50-2069, **referencing docket number 054-602**.

Respectfully submitted,

By: /Tracy M Heims 53010/
Tracy M. Heims
Reg. No. 53,010

Apex Juris, pllc
12733 Lake City Way Northeast
Seattle, Washington, 98125
Email: tracy@apexjuris.com
Phone (206) 664-0314
Fax (206) 664-0329